

REMARKS

The Office Action raised an issue with regards to Claim 1, Line 9, on the spelling focusing, and Claims 4 and 5 on multiple dependent claims.

Applicant had previously corrected those issues in a Preliminary Amendment of April 27, 2004, which was received in the U.S. Patent Office on April 30, 2004.

Upon receipt of this Office Action, applicant submitted a letter to the Examiner on June 10, 2005, pointing out that a Preliminary Amendment had been filed addressing not only the multiple dependent claims, but adding new claims into the Application. Applicant received an Auto Reply Facsimile Transmission acknowledging receipt of this submission. Subsequently, applicant left a phone message on August 3, 2005 for Examiner Letscher, requesting a response on the Preliminary Amendment with a new response time being set for the new claims that were not acted upon. (See attached copies.)

Applicant would request that any response to the present status of claims take into consideration that applicant has never received a First Office Action on the Preliminary Amendment claims which are of record in the U.S. Patent Office. However, to be responsive to the Office Action and to continue the prosecution of the present matter, applicant requests that the following comments and remarks be taken into consideration.

The present invention is in a relatively crowded field of CD players and DVD players, and more particularly addresses an economical and practical solution to improving the performance of such devices by enabling a consumer to clean a pick-up lens in such optical disc players. As mentioned in our description of related art, numerous attempts have been made to permit a user to clean an optical disc player without having to have a skilled technician take the machine apart and clean it. As can be imagined, the cost of technical labor can sometimes

exceed the current value of an optical disc player and under certain circumstances, optical disc players in a vehicle can be difficult to access and clean.

In this environment, the present inventor has recognized this problem and has provided a unique method and apparatus that can be economically employed.

A CD player or a DVD player generally has an initial operating protocol upon the insertion of an optical disc, wherein the optical pick-up head that is to record reflections of laser light off of the recording surface of the optical disc, is advanced to a start position and driven relative to the surface of the disc to establish an in focus position. When this enabling procedure has been satisfactorily accomplished, the optical disc is then rotated for the pick-up of data on the disc. If the optical player is incapable of establishing an in focus position for the optical pick-up head, it will assume that there is an error condition and it will suspend the subsequent rotation of the disc to indicate an error signal.

The present inventor has utilized this knowledge of the operation protocols of such optical disc players to enable a relatively simple manual cleaning operation of the lens on the optical pick-up head by intentionally inducing an error signal in the optical disc player. Thus, the present invention provides a cleaning member on a disc substrate of a configuration to contact the pick-up or objective lens of the optical disc device in a stalled position.

The cleaning member is provided on a non-focusing surface or focus preventing face of the lens cleaner disc whereby an intentional error signal can be induced in the optical disc player, while positioning the cleaning member so that it can be manually and relatively moved in a cleaning operation by an operator external of the optical disc player.

While external cleaning devices have been utilized, applicant is not aware of the intentional provision of a non-focusing support surface to purposely induce an error signal in an

optical disc device. These features are set forth, for example, in the currently amended Claim 1 and Claim 12, and in the method dependent claims along with the independent method Claim 15.

A close review of the cited prior art indicates that it neither appreciates nor suggests this relatively unique apparatus and method for cleaning optical disc players.

The Office Action primarily relied upon the *Kobayashi* (Laid-Open Japanese Publication 11-134830) that is assigned to the same assignee of the present invention.

This reference is directed at provided a specific display section that indicate the centers of three different types of CD players on the face of a compact disc substrate. The compact disc substrate, however, is specifically defined as having brushes mounted to protrude “on the side of a signal reading surface of a disc 1 having substantially the same specification as a compact disc, thus constituting a cleaning surface.”

It is clear that this reference would not suggest to a person of ordinary skill in this field the advantages of intentionally providing a non-focusing support surface for the cleaning member to intentionally induce an error signal and suspend further operation of an optical disc device that has been powered to an “on” state. A person of ordinary skill in this field would be taught by *Kobayashi* that there is a signal reading surface on a disc with substantially the same specifications as a conventional compact disc that is to be played in the optical disc device.

Accordingly, applicant respectfully traverses the statement in Paragraph 6 of the Office Action that the *Kobayashi* reference would suggest that the recording face is not the subject of focusing as the device is off while cleaning the optical head. It is respectfully submitted that this is an observation made in hindsight from the present Application.

In addition, rejection based on the combination of the *Kobayashi* reference in view of the Laid-Open Japanese Patent Application 63-313378 does not resolve this issue.

See *Al-Site Corp. v. VSI International*, 174 F.3d 1308 (Fed. Ca. 1999) at page 1324:

VSI is unable, however, to point to any specific teaching or suggestion for making this combination. VSI instead relies on what it presumes is the level of knowledge of one of ordinary skill in the art at the time of the invention to supply the missing suggestion to combine. In the first place, the level of skill or jury views the prior art and the claimed invention. This reference point prevents these deciders from using their own insight or, worse yet, hindsight, to gauge obviousness. Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."). Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. See *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 (USPQ2d 1053, 1057 (Fed. Cir. 1991).

Applicants have provided a positive recitation in the independent apparatus Claims 1 and 12 of a specific characteristic of a non-focusing or focus preventing surface or face that is not recognized nor taught in any of the references of record.

As can be appreciated, sometimes it is the recognition of both the problem and the environment that comprises the innovative novelty worthy of patent protection. It is respectfully submitted that these elements in our claims meet this criteria of patentability.

The U.S. Patent Office is cognant that frequently the recognition of the problem can be an ingredient in the invention, as noted in the case of *In re Zukor*, 111 F.3d. 887, 42 USPQ2d 1476, 1479 (Fed. Cir. 1997):

Finally, to say that the missing step comes from the nature of the problem to be solved begs the question because the Board has failed to show that this problem has been previously identified anywhere in the prior art. See *in re Spinnable*, 405 F.2d 578, 585, 160 USP! 237, 243 (CCPA 1969) ("[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified.

Additionally, Claim 15 provides a method for powering an optical disc player to an operation state, and inserting a disc substrate with a cleaning member on a non-focusing surface whereby an intentional error signal is cause to suspend the operation of the optical disc player when it is unable to focus on the non-focusing surface, thereby permitting a manual moving of the cleaning member relative to the lens to permit a relatively simple cleaning of the lens.

The specific method steps again recognize the unique utilization of the normal disc player operating procedures to enable the preliminary set up of the operating conditions of the optical disc player to be purposely altered to ensure both a static and optimum positioning of the object lens in the optical pick-up device to provide proficient mechanical cleaning while preventing the capability of causing other debris such as grease, which could further contaminate the optic lens if the disc was rotating while be driven by the motor of the optical disc player.

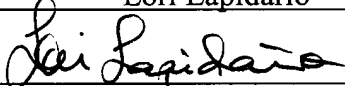
As can be appreciated, it is not the complexity of either the solution to a problem or the steps required to practice the method of an invention that is necessary for a patentable invention. It is, however, the uniqueness and non-obviousness that must be taken into context in a relatively crowded field with a substantial amount of highly skilled scientists and engineers addressing a large commercial market. Weighing those factors clearly indicates that patentable subject matter is contained in the present Application.

As can be appreciated, these features are also set forth in the dependent claims that have never been addressed in the Preliminary Amendment.

If the Examiner believes a telephone interview will assist in the prosecution of this matter, he is respectfully requested to contact the undersigned attorney at the listed phone number.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 6, 2005.

By: Lori Lapidario


Signature

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Very truly yours,

SNELL & WILMER L.L.P.


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